

Serial No. 09/676,584
Response to Non-Final Office Action
Mailed November 15, 2006
Response dated February 14, 2007

Filing Date: September 29, 2000

REMARKS

Claims 19-28 are pending in the present application. Claims 1-18 have been canceled without prejudice and preserving the right to pursue patent protection of the invention described therein. Claim 19 has been amended to further clarify that which was previously claimed. Reconsideration of the pending claims is respectfully requested in view of the below comments.

1. The 35 U.S.C. 112 first paragraph rejections

Claims 1-28 were rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement because the specification does not describe the subject matter contained in the claims in such a way as to enable one skilled in the art to make and use the claimed invention. Applicant respectfully traverses these rejections since the burden of establishing a reasonable basis for why the scope of protection provided by the claims is not enabled by the disclosure has not been met for at least the following reasons. (MPEP 2164.04)

1. **Applicant respectfully traverses the assertions on page 3 of the office action mailed November 15, 2006 that "the disclosure presented by the applicant failed to provide a description (sic) on how to make and use those various tools."** To the contrary, each of the tools described in the pending claims are illustrated in Figure 1 of the application, and described in sufficient detail in the specification. For example with reference to Claim 19:

The software distribution tool (80) is described on at least page 9 line 22 through page 13 line 2.

The configuration and asset management tool (82) is described on at least page 13 line 3 through page 15 line 3.

The fault management and recovery management tool (84) is described on at least page 15 line 4 through page 16 line 6.

The capacity planning tool (86) is described on at least page 16 lines 9-30.

The performance management tool (88) is described on at least page 17 lines 1-17.

The license management tool (90) is described on at least page 17 line 18 through page 18 line 15.

The remote management tool (92) is described on at least page 18 line 16 through page 19 line 5.

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The event management tool (94) is described on at least page 19 lines 6-20.

The system monitoring and tuning tool (96) is described on at least page 19 lines 21-31.

The security tool (98) is described on at least page 20 line 1 through page 24 line 26 and Figure 3.

The user administration tool (100) is described on at least page 24 line 27 through page 25 line 31.

The production control application set (102) is described on at least page 26 line 1 through page 27 line 6.

The help desk tool (104) is described on at least page 27 line 7 through page 28 line 8.

"The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims." (MPEP 2163(II)(A). There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *Id.* (see *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976).) Based on the above described clear and unequivocal explanation in the specification using terms similar to the limitations included in the claims, and the lack of specific factual evidence or reasons in the Office Action mailed November 15, 2006, Applicant respectfully requests withdrawal of the enablement rejections of Claims 19-28. In the alternative, Applicant respectfully requests a non-final office action that includes presentation of a prima facie case of factual and specific evidence or reasons supporting lack of enablement rejections, instead of what appears to be simply personal opinions of a general nature. "The examiner should never make the determination [of lack of enablement] based on personal opinion. The determination should always be based on the weight of all the evidence." (MPEP 2164.05)

2. Applicant respectfully traverses the assertion on page 4 of the office action mailed November 15, 2006 that:

[T]he claims provides a list of tools that were already well known in the art (ex. Software distribution tool, a configuration and asset tool, a fault management and recovery tool....) without describing how to make and how

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to use the invention or presenting any improvement. Furthermore, the Evidence presented failed to provide any improvement to the tools already known in the art and available on the Market at the time of the publication of the Evidence presented (See Exhibit D, page 12-4, *Software distribution Tool already available form (sic) Microsoft, HP and Tivoli*; See Exhibit D, page 12-8, *Automatic asset and configuration collection capability is included in many vendors solutions, including Openview from HP and POLYCENTER System Census from Digital Equipment Corp*).

Applicant respectfully asserts that general unsupported allegations that the claimed tools are well known in the art does not support the Examiner's burden of establishing a reasonable basis for a lack of enablement rejection. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (See MPEP 2164.01) Accordingly, if some of the tools are well known, as asserted in the office action mailed November 15, 2006, an assertion of lack of enablement as to such tools is completely without merit.

Also, an unsupported assertion containing no credible evidence that each and every claimed limitation is well known in the art does not meet the required burden of the Examiner to fully support a lack of enablement rejection. In addition to the fundamental concept that each and every limitation of a claim must be anticipated to reject a claim for lack of novelty (35 U.S.C. §102), as the court has stated, "it is incumbent upon the Patent Office, whenever a rejection on this basis [lack of enablement] is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with *acceptable evidence or reasoning* which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." (emphasis added) *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). In the instant case, not only have unsupported sweeping assertions of lack of novelty without evidence or reasoning been made to support a lack of enablement rejection, but also, the lack of enablement assertions are so general and without specific facts or evidence that Applicant is unable to provide specific evidence and/or declarations/affidavits in rebuttal. Accordingly, Applicant respectfully requests an opportunity

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to address specific assertions of lack of enablement in a non-final office action. Alternatively, Applicant respectfully requests withdrawal of the enablement rejections of the pending claims.

II. The 35 U.S.C. §101 Rejections

Claims 1-28 have been rejected as failing to comply with 35 U.S.C. §101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The office action mailed November 15, 2006 has apparently based this assertion on the fact that "[t]he evidence presented in the specification and Exhibits C, D and E leads the office to conclude that the Evidence are (sic) not sufficient to teach how to make and use the claimed invention. Information is missing about many essential part (sic) or relationships between parts." Pursuant to MPEP 2107(II)(C)(1), Applicant respectfully traverses these rejections on the basis that the operations architecture and the method of providing an operations architecture for a netcentric computing system described in respective claims 19 and 24 are supported by a specific and substantial utility that is credible, well established, and is disclosed by both the claims and the specification. "As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope." MPEP 2107(III)(A)

In the instant case, the entire specification describes various instances of specific and substantial utility of the operations architecture. For example, on at least page 5 lines 22-31 and in Figure 2 a netcentric computing system (12) is described. On at least page 8 lines 12-19 of the specification the specific and substantial utility of the operations architecture is described:

Referring to FIG. 1, the operations architecture 10 includes the tools and support services required to keep a production system up and running well in a netcentric computing system 12. The preferred operations architecture 10 supports a netcentric execution architecture 40 and a development architecture 42 that are located on the netcentric computing system 12. It differs from the execution architecture 40 and the development architecture 42 in that the operations architecture's 10 primary users are systems administrators and production support

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personnel. In addition, it differs from the operations infrastructure in that the operations infrastructure represents operations processes and organization as well as the technologies and tools.

In addition, specific and substantial utility of individual tools are described throughout the specification and claims, such as, on page 3 lines 26 through 31:

The preferred operations architecture includes a software distribution tool for providing automated delivery to, and installation of, an application on the server or the client. A configuration and asset management tool is also included in the operations architecture for managing a plurality of predetermined assets connected with said netcentric computing system. These assets could be servers, clients, printers, and various other computing devices that are connected with the netcentric computing system.

As described in MPEP 2107 et al., "Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea, or to manipulation of abstract ideas, or does not produce a useful result." "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. §101." MPEP 2106(II)(A) As detailed above, clearly, the subject matter of Claims 19-28 include limitations to a practical application in the technological arts. In addition, Claim 19 describes a system that affirmatively recites the limitation of a server, which is a machine, and therefore is encompassed in one of the four categories of subject matter identified by 35 U.S.C. §101. Further, Claim 24 is a method describing a process, which is also encompassed in one of the four categories of subject matter identified by 35 U.S.C. §101. Accordingly, pursuant to MPEP 2107.01, the claimed subject matter is useful, and is encompassed in categories that are eligible for patent protection. Thus, withdrawal of the 35 U.S.C. §101 rejections of the pending claims is respectfully requested.

With regard to the assertion in office action mailed November 15, 2006 that "information is missing about many essential part (sic) or relationships between parts." Applicant respectfully traverses the assertion that any information is missing from the present application, or the previously submitted portion of Chapter 3, Chapter 12, and Chapter 28. As previously discussed, each and every limitation of the pending claims is described in detail in the pages of the present

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application. In addition, Claim 19 has been amended to clarify the relationship between the various tools, and Claim 24 includes many steps that specifically indicate a relationship within the context of a netcentric computing system. If any information is missing about "many essential part (sic) or relationships between parts" as has been asserted, Applicant respectfully contends, pursuant to MPEP 2164.06(a) that "the examiner should *specifically identify* what information is missing, and why the missing information is needed to provide enablement" (emphasis added) to allow the Applicant an opportunity to respond to the specific issues identified.

III. Rejections under 35 U.S.C. § 102(e)

On page 2 of the Office Action mailed November 15, 2006 it is indicated that the rejections of claims 1-28 under 35 U.S.C. § 102(e) as anticipated by Guheen *et al.* (U.S. Patent Publication No. 2004/0107125) were being maintained because "Applicant failed to provide any proof of actual reduction to practice prior to the date of the reference [Guheen]." Applicant respectfully traverses this requirement since 37 CFR § 131(b) does not require an actual reduction to practice where there is conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice. (see MPEP 2138.05 where it is discussed that a sufficient showing of facts is possible in any one of three ways pursuant to 37 CFR § 131(b)) In the instant case, Applicant has provided overwhelming proof of conception of the claimed invention prior to the effective date of Guheen (May 27, 1999). In addition, as provided in item 7 of the declarations of each of the named inventors that were filed with the request for continued examination (RCE) on November 16, 2005, Applicant has provided evidence of diligence until a constructive reduction to practice occurred when US Provisional Patent Application Serial No. 60/156,962 was filed on October 1, 1999. Applicant has overcome all of the objections to the declarations and is in full compliance with 37 CFR § 1.131. Accordingly, Guheen does not qualify as prior art under 35 U.S.C. § 102(e) and should be removed from consideration.

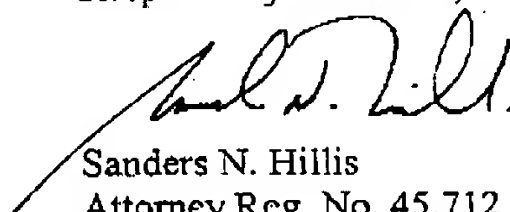
Conclusion

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With this amendments and response, the present pending claims of this application are now allowable, and Applicant respectfully requests the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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